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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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7590

05/15/2009

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EXAMINER

CASLER, TRACI

ART UNIT

PAPER NUMBER

3629

MAIL DATE

DELIVERY MODE

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 09/921,199	<b>Applicant(s)</b> HOFRICHTER ET AL.	
	<b>Examiner</b> Traci L. Casler	<b>Art Unit</b> 3629	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 02 March 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1,2,4,8-10,14-20,24-28,30,31,36-39 and 43-50 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,2,4,8-10,14-20,24-28,30,31,36-39 and 43-50 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                       | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>11/14/2008</u>  | 6) <input type="checkbox"/> Other: _____                          |

### **DETAILED ACTION**

This action is in response to papers filed on March 2, 2009.

Claims, 3, 5-7, 11-13, 21-23, 29, 32-35 and 40-42 have been cancelled.

Claims 1, 9, 19, 30, 38 and 48 have been amended.

Claims 1-2, 4, 8-10, 14-20, 24-28, 30-31, 36-39 and 43-50 are pending.

Claims 1-2, 4, 8-10, 14-20, 24-28, 30-31, 36-39 and 43-50 are rejected.

### ***Claim Rejections - 35 USC § 101***

1. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-2, 4, 8-10, 14-18 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

As to claims 1-2, 4, 8-10, 14-18, in order for a method/process claim to fall within statutory subject matter the claims be tied to either a machine or transformation. A two-branched inquiry is used to show that a claims is statutory by either tying it to a particular machine or a by showing that the claim transforms an article. The use of a specific machine or transformation of an article must impose "meaningful limits" on the claims' scope to impart patent-eligibility. The involvement of the machine or transformation in the claimed process must not merely be insignificant extra-solution activity, such as storing, gathering, displaying, sending and receiving of data as this does not impart a significant impact in the solution to the process. See in re Bilski.

***Claim Rejections - 35 USC § 103***

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-2, 4, 8-10, 14-20, 24-28, 30-31, 36-39 and 43-50 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent Publication 2003/0174861; Levy et al; Connected Audio and Other Media Objects. Hereinafter referred to as Levy, in view of US Patent 5, 638, 443 Stefik et al; System for Controlling the Distribution and Use of Composite Digital Works. Hereinafter referred to as Stefik in further view of US Patent 6,848,002 Detlef System and method for optimal selection and presentation of streaming media types. Hereinafter referred to as Detlef.

3. As to claims 1, 9, 19, 30, 38, 48 and 49 Levy teaches

4. transmitting a request to download data, wherein said data comprises a content file; **(Pg. 5 ¶ 42 “when the user request a file in a streaming or compressed file format)**

5. receiving identification information and data downloaded from one of a plurality of content providers storing said data, said identification information identifying said one content provider and obtained by said one content provider from an original content provider of said data; transmitting, to said original content provider, said identification

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information for said one content provider, which downloaded said data, along with payment for the download of said data; **(Pg. 4 ¶ 34 the OID is encoded with additional information about the distributor and identifies the object Pg. 6 ¶ 55 the registration process provides information identifying the attribute of the audio object such as its distributor(content provider) or broadcaster.)**

6. transmitting, to said original content provider, a request for a distribution tool identifying said client as an additional content provider that distributes said data to other clients; **(PG. 5 ¶ 44 the distributor ID is used for copy control, played, transferred, recorded)**

7. receiving said distribution tool; *wherein the distribution too includes identification information for the server and the client* and **(Pg 6 ¶ 61 the clearing house embeds the media objects and pushes them to the user) (PG. 2 ¶ 15 identifier may identify media object, entities or actions...)**

8. *Levy teaches the distribution tool is embedded in said data and the distribution tool is subsequently transmitted to the server by the different client after the different client downloads said data from said client(Pg. 3 ¶22-23, Pg. 4 ¶ 30) The examiner notes that these limitations are not positively recited and and the steps required(ie different client downloads data) to initiate these steps are not performed therefore the limitations as claimed are outside the scope of the claim and impart no patentable weight and/or eligibility. Applicant never positively claims distributing the data to the different client or the different client downloading data.*

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9. Levy fails to teach applying said distribution tool to said data to identify said client as an additional content provider prior to distributing said data to another client, wherein said clients are operated by users of the content file.

10. However, Stefik teaches “distribution and use scenarios” in which he teaches utilizing the consumer as a distributor of the digital works either as a paid or unpaid distributor.”(C. 43 l. 28-68). It would have been obvious to one skilled in the art at the time of invention to combine Stefik's consumer distributors with Levy's retail distributors as a simple substitution of the consumer as the distributor rather than a retailer or broadcaster. This would allow the rights holder to expand their audience while maintaining the usage rights and associated fees while yielding predictable results of expanding the market and audience of the digital works.

11. Levy/Stefik fail to teach the server maintaining a list of plurality of content providers and updating the list to include the client as a content provider. However, Detlef teaches a list of content providers that is updated for current providers after accessing registry information(C. 4 l. 61-67). It would have been obvious to one of ordinary skill in the art to include in the content distribution system of Levy/Stefik the ability update the content provider list as providers are registered as taught by Detlef since the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

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12. As to claims 2, 4, 10, 14-15, 20 24-25, 31, 36, 39 and 43-44 Levy teaches the distribution tool as being an embedded watermark(Pg 1 12; Pg. 3 ¶ 30).

13. As to claims 8, 16-17, 26-28, 37, 45-47 and 50 Levy teaches transmitting payment to download data and paying distributor royalties(Pg. 4 ¶ 34).

### ***Response to Arguments***

14. Applicant's arguments filed March 02, 2009 have been fully considered but they are not persuasive.

15. Applicants arguments are directed towards the new limitations that have been added. The examiner has addressed said limitations in the proceeding rejection.

### ***Conclusion***

16. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Traci L. Casler whose telephone number is 571-272-6809. The examiner can normally be reached on Monday-Thursday 6:00 am-4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on 571-272-6812. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Traci L Casler/  
Examiner, Art Unit 3629

/JOHN G WEISS/  
Supervisory Patent Examiner, Art Unit 3629